

## REMARKS

This application has been reviewed in light of the Office Action dated February 8, 2005. Claims 22-33 are presented for examination. Claims 1-21 have been canceled, without prejudice or disclaimer of subject matter. Claims 22-33 have been added to provide Applicant with a more complete scope of protection. Claims 22, 25, 26, 29, 30 and 33 are in independent form. Favorable reconsideration is requested. The canceled claims will not be further addressed herein.

The Office Action states that a faxed copy of the Declaration was received in response to the Notice To File Missing Parts. Applicant respectfully disagrees. The Declaration and Response To Notice To File Missing Parts was hand carried to the U.S. Patent and Trademark Office (USPTO) on September 19, 2001, as evidenced by the returned receipt postcard bearing the stamp of the Patent and Trademark Office, a copy of which is attached hereto. Subsequently, on January 26, 2005, Examiner Williams contacted Applicant's attorneys requesting that they fax a copy of the Declaration and Response To Notice To File Missing Parts to her because the USPTO had mis-placed the original submission. Applicant's attorneys complied with her request.

The Office Action objected to the Abstract of the disclosure because it exceeds 25 lines of text and 150 words.

Applicant has carefully reviewed and amended the Abstract to overcome the noted objection, and its withdrawal is respectfully requested.

The Office Action objected to the specification because of the informalities noted in paragraph 5 of the Office Action.

The specification has been carefully reviewed and amended as deemed necessary overcome these objections. Specifically, on page 8, line 25, "an RAM" was

replaced with “a RAM”; on page 9, line 23, “an ROM” was replaced with “a ROM”; on page 12, line 12, the reference to “P1” was deleted; and on page 33, line 26, “an FAX” was replaced with “a FAX”. The sentence beginning on page 32, line 13 was also amended along the lines suggested by the Examiner. It is believed that the objections have been obviated, and their withdrawal is respectfully requested.

Claim 1 was provisionally rejected under the judicially created doctrine of obviousness-type double patenting as being unpatentable over Claim 1 of co-pending application No. 09/865,697. Claims 1, 8 and 15 were rejected under 35 U.S.C. § 102(b) as being anticipated by JP 11-17877 (Kido). Claims 2-5, 7, 9-12, 14, 16-19 and 21 were rejected under 35 U.S.C. § 103(a) as being unpatentable over Kido in view of U.S. Patent No. 5,815,289 (Yoshida). Claims 6, 13 and 20 were rejected under 35 U.S.C. § 103(a) as being unpatentable over Kido in view of Yoshida and in further view of U.S. Patent No. 6,447,113 (Silverbrook).

Cancellation of Claims 1-21 renders their rejections moot, but Applicant submits the following comments regarding the patentability of new Claims 22-33 over these cited references.

Claim 22 is directed to a facsimile apparatus for reading images of original sheets in which both-side and one-side original sheets exist mixedly and transmitting them to a receiver station, including reading means for reading the images on both sides of the original sheet, means for discriminating whether the images on both sides read by the reading means have effective image information or not, and control means adapted for selectively determining use of a both-side transmitting procedure if both sides of the original sheet have effective image information or use of a one-side transmitting procedure if both sides of the original sheet do not have effective image information, for each

transmission of one original sheet, in accordance with a result of the discrimination of the discriminating means; and for transmitting to the receiver station both-side transmission control information including a page number and information regarding front or reverse side of the original sheet, for each side of the original sheet, when the both-side transmitting procedure is used, and omitting the transmission of the both-side transmission control information when the one-side transmitting procedure is used.

One important feature of Claim 22 is a control means adapted for “selectively determining use of a both-side transmitting procedure if both sides of the original sheet have effective image information or use of a one-side transmitting procedure if both sides of the original sheet do not have effective image information, for each transmission of one original sheet, in accordance with a result of the discrimination of the discriminating means; and for transmitting to the receiver station both-side transmission control information including a page number and information regarding front or reverse side of the original sheet, for each side of the original sheet, when said both-side transmitting procedure is used, and omitting the transmission of said both-side transmission control information when said one-side transmitting procedure is used.”

Kido and Yoshida, alone or in combination, are not seen to disclose or suggest the apparatus defined by Claim 22, particularly with respect to the control means feature of Claim 22.

Kido relates to a facsimile device that includes a first readout part that reads out one surface of an original and a second readout part that reads the other surface of an original. A first transmission data memory part temporarily stores the data read out by the first readout part, and a second transmission data memory part temporarily stores the data read out by the second readout part. Kido discusses deciding whether data exists on both

surfaces or one surface and, if data exists on both surfaces, the original of both surfaces is simultaneously read out by two readout means and temporarily stored in each corresponding memory. If the original has data on one surface, it is read out by any of the two readout means.

Nothing has been found in Kido that teaches or suggests a “control means adapted for selectively determining use of a both-side transmitting procedure if both sides of the original sheet have effective image information or use of a one-side transmitting procedure if both sides of the original sheet do not have effective image information, for each transmission of one original sheet, in accordance with a result of the discrimination of the discriminating means; and for transmitting to the receiver station both-side transmission control information including a page number and information regarding front or reverse side of the original sheet, for each side of the original sheet, when said both-side transmitting procedure is used, and omitting the transmission of said both-side transmission control information when said one-side transmitting procedure is used,” as recited in Claim 22.

Yoshida relates to a facsimile apparatus for transmitting one-sided and both-sided originals. Yoshida discusses a both sides original lamp that can be depressed by an operator. Then, after the operator selects a call destination, a display unit displays that “SET FRONT PAGE OF THE ORIGINAL FROM THE FIRST ONE” and the operator puts the originals on the original holder with the front pages being directed to be read by a reading system. After a start key is pressed, the front pages of the document are read and a counter counts the number of pages. Upon completion of reading all the front pages, the display unit displays that “SET BACK PAGE OF THE ORIGINAL FROM THE LAST ONE”. The operator then puts the originals on the original holder with the back pages

being directed to be read by the reading system and presses the start key. The facsimile apparatus then reads the back pages and a counter counts the number of pages.

Yoshida does not teach or suggest a means for discriminating whether the images on both sides read by said reading means have effective image information or not, as recited in Claim 22.

Further, while Yoshida discusses various controls in transmitting one-sided and both-sided originals, it does not clearly describe what communication procedures are used to transmit the one-sided original sheets and both-sided original sheets, respectively. Accordingly, Yoshida does not teach or suggest a “control means adapted for selectively determining use of a both-side transmitting procedure if both sides of the original sheet have effective image information or use of a one-side transmitting procedure if both sides of the original sheet do not have effective image information, for each transmission of one original sheet, in accordance with a result of the discrimination of said discriminating means; and for transmitting to the receiver station both-side transmission control information including a page number and information regarding front or reverse side of the original sheet, for each side of the original sheet, when said both-side transmitting procedure is used, and omitting the transmission of said both-side transmission control information when said one-side transmitting procedure is used,” as recited in Claim 22.

Claim 22 is believed clearly allowable over Kido and Yoshida, taken separately or in any proper combination.

Independent Claims 26 and 30 are control method and storage medium claims, respectively, corresponding to apparatus Claim 22, and are believed to be patentable over Kido and Yoshida for at least the same reasons as discussed above in connection with Claim 22.

Claim 25 is directed to a facsimile apparatus for reading images of original sheets in which both-side and one-side original sheets exist mixedly and transmitting them to a receiver station, including reading means for reading the images on both sides of the original sheet, means for discriminating whether the images on both sides read by the reading means have effective image information or not; and control means adapted for selectively determining use of a both-side transmitting procedure if both sides of the original sheet have effective image information or use of a one-side transmitting procedure if both sides of the original sheet do not have effective image information, for each transmission of one original sheet, in accordance with a result of the discrimination of the discriminating means, and for transmitting to the receiver station a value to be allocated to the front side when it is assumed that the one-side original sheet is the both-side original sheet, as a page number of the one-side original sheet, in case the one-side transmitting procedure is used.

The Office Action cites column 23, lines 6-16 as disclosing the feature of a control means adapted for transmitting to the receiver station a value to be allocated to the front side when it is assumed that the one-side original sheet is the both-side original sheet, as a page number of the one-side original sheet, in case the one-side transmitting procedure is used. However, that passage merely discusses a both sides original lamp that is turned on when perfect information is to be transmitted. The both sides original lamp is turned off when clear pulses are generated on a signal line. In this way, the both sides original lamp is alternately turned off and on in response to filing selection button depression pulses on a signal line. However, Yoshida does not teach or suggest the feature of “transmitting to the receiver station a value to be allocated to the front side when it is assumed that the one-side original sheet is the both-side original sheet, as a page number of the one-side original

sheet, in case the one-side transmitting procedure is used,” as recited in Claim 25.

Claim 25 is believed to be clearly allowable over Kido and Yoshida, taken separately or in any proper combination.

Independent Claims 29 and 33 are control method and storage medium claims respectively corresponding to apparatus Claim 25, and are believed to be patentable over Kido and Yoshida for at least the same reasons as those discussed above in connection with Claim 25.

A review of the other art of record has failed to reveal anything which, in Applicant’s opinion, would remedy the deficiencies of the art discussed above, as references against the independent claims herein. Those claims are therefore believed patentable over the art of record.

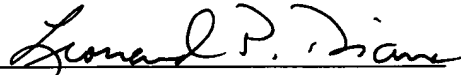
The other claims in this application are each dependent from one or another of the independent claims discussed above and are therefore believed patentable for the same reasons. Since each dependent claim is also deemed to define an additional aspect of the invention, however, the individual consideration or reconsideration, as the case may be, of the patentability of each on its own merits is respectfully requested.

Applicant notes the provisional rejection of Claim 1 under the judicially created doctrine of obviousness-type double patenting in view of co-pending application no. 09/865,697. As that application has not yet issued, this rejection cannot be made non-provisional. Accordingly, Applicant respectfully requests that this rejection be withdrawn.

In view of the foregoing amendments and remarks, Applicant respectfully requests favorable reconsideration and early passage to issue of the present application.

Applicant undersigned attorney may be reached in our New York office by telephone at (212) 218-2100. All correspondence should continue to be directed to our below listed address.

Respectfully submitted,

A handwritten signature in cursive script, reading "Leonard P. Diana", written over a horizontal line.

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